



3724

#7 / Response

PATENT
Customer Number 22,852
Attorney Docket No. 2734.0475-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Joshua M. BROEHL

Application No.: 09/736,419 ✓

Filed: December 15, 2000

For: SHEET MATERIAL DISPENSER
WITH TRANSFER SYSTEM AND
METHOD

Group Art Unit: 3724

Examiner: Thomas J. DRUAN

RECEIVED
OCT 16 2002

Commissioner for Patents and Trademarks
Washington, DC 20231

TECHNOLOGY CENTER R3700

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In the Office Action dated September 12, 2002, the Examiner required restriction under 35 U.S.C. § 121 between the following claim groupings:

- Group I - Claims 3-6 and 19-22, allegedly drawn to "roller surface characteristics";
- Group II - Claims 10-12 and 25-27, allegedly drawn to "a drive means";
- Group III - Claims 13 and 28, allegedly drawn to "shield";
- Group IV - Claims 14-15, 18, 23, and 29-30, allegedly drawn to "a transfer mechanism";
- Group V - Claims 16 and 31, allegedly drawn to "a cutting member"; and
- Group VI - Claims 32-34, drawn to a method of dispensing sheet material.

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In the Office Action, the Examiner indicated that claims 1 and 17 are common to each of Groups I-V and that claims 2, 7-9, 18, and 24 will be examined with the elected claim grouping. Applicant requests clarification regarding the status of claim 18, because the Office Action includes this claim in Group IV and also indicates that it will be examined with the elected claim grouping.

Applicant respectfully requests the Examiner to reconsider and to withdraw the restriction requirement. In particular, Applicant respectfully requests the Examiner to withdraw the restriction requirement applied to the claims of Groups I-V. The Examiner asserted that Groups I-V are related as "subcombinations usable in a single combination."

Applicant submits that the restriction requirement is improper and should be withdrawn because **Groups I-V are not "subcombinations."** According to M.P.E.P. §§ 806.05(a) and 806.05(d), a "subcombination" is a structural part of a combination, and two or more "subcombinations" are capable of being used in a single combination.

An examination of Groups I-V reveals that there groups could not be properly considered to be separate "subcombinations." **Groups I-V are all directed to the same general combination, namely a dispenser, rather than being directed to separate "subcombinations" disclosed as being usable together in the same combination.** Therefore, Groups I-V cannot properly be considered to be "subcombinations" according to the definition of that term in the M.P.E.P.

To have a proper "subcombination" restriction requirement between two asserted subcombinations, the "[E]xaminer must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination." (M.P.E.P. §

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806.05(d); emphasis supplied) Applicants do not believe that the Examiner has met this required burden. In this application, the disclosed combination is a dispenser and the claims of Groups I-V are directed to a dispenser. Applicants respectfully submit that it is improper to have a "subcombination" restriction requirement between Groups I-V, because each of the claims of these groups only has utility in the same disclosed combination, namely a dispenser.

Furthermore, it would not constitute an undue burden to search all of the subject matter because a substantially overlapping search is required to examine each of the claim groupings.

If the search and examination of an entire application can be made without serious burden the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

For at least these reasons, Applicant respectfully requests the Examiner to withdraw the restriction requirement and to examine all of the pending claims together. If the Examiner insists on maintaining the improper restriction requirement, Applicant respectfully requests the Examiner to make this requirement final so that Applicant will have an opportunity to petition for review of this decision.

In the event that the Examiner decides to continue the improper restriction requirement, Applicant provisionally elects to prosecute Group VI, claims 32-34. For the reasons set forth above, this election is made with traverse.

The Office Action contains numerous assertions concerning the invention(s) and claims. Applicant declines to automatically subscribe to any assertion in the Office Action, regardless of whether it is specifically addressed above.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: October 11, 2002

By:



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